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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,300	03/16/2005	Stephen Edward Methuen Forsey	71735	6616
23872	7590	02/05/2008		
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227			EXAMINER KAYES, SEAN PHILLIP	
			ART UNIT 2833	PAPER NUMBER
			MAIL DATE 02/05/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/528,300	FORSEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sean Kayes	2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9,12,14,16,19 and 20 is/are rejected.
- 7) ☒ Claim(s) 3,4,6,10,11,13,17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "A two-state chronograph with switching means."

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2, 5-9, 12, 14, 16, 19, and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. US 7232254 in view of Dubois (US 4389122.)

4. With respect to claim 1 US patent, 7232254, claims a chronograph watch movement, including a frame and, carried by said frame:

- an energy source (energy is inherently required to perform time measurement),
- a time base (line 5 of claim 1) powered by the energy source,
- a first, going train ("current time display means" line 3 claim 1), driven in rotation, in synchronism with the time base, and including a mobile for units of time selected from among the minutes and hours of the current time, and

a chronograph mechanism, which includes:

- a second, chronograph train ("measured time display means" line 4 claim 1), to be driven, upon demand, in synchronism with the time base and including first and second wheels respectively completing one revolution in sixty seconds and one revolution in a time allowing the measured units of time, selected from between the hours and minutes, to be displayed and arranged coaxially with said mobile, said wheels being arranged so that they can carry display means for displaying a measured time,
- a control device (lines 6-7 claim 1) for starting and stopping said wheels of the second train, and
- a device ("a reset device" lines 8-9 claim 1) for resetting the display means,
- wherein said mechanism further includes switching means (lines 6-7 claim 1) arranged such that they can occupy two states, in one of which they connect the second wheel of the chronograph train to the mobile of the going train, such that

the display means carried by the second wheel display the unit of current time equivalent to that of the measured time.

5. With respect to claim 8 US patent, 7232254, claims a chronograph watch movement, including a frame, the chronograph watch movement comprising:

- an energy source (energy is inherently required to perform time measurement);
- a time base (line 5 of claim 1) powered by the energy source;
- a current measuring time hand ("current time display means" line 3 claim 1);
- a first drive train ("current time display means" line 3 claim 1 and "movement" line 1) rotating in synchronization with said time base, said first drive train element including a first gear connected to said current measuring time hand;

a chronograph mechanism including:

- a first display means and a second display means ("measured time display means" line 4 claim 1);
- a second chronograph drive train ("measured time display means" line 4 claim 1 and "movement" line 1) actuated in synchronism with said time base, said second chronograph drive train including a first chronograph gear and a second chronograph gear, said first chronograph gear completing one revolution in sixty seconds, said second chronograph gear completing one revolution in sixty minutes, said first chronograph gear and said second chronograph gear being arranged coaxially with said first gear of said first drive train, said first

chronograph gear being connected to said first display means, said second chronograph gear being connected to said second display means;

- a control means (lines 6-7 claim 1) for controlling said first chronograph gear and said second chronograph gear;
- a resetting means ("a reset device" lines 8-9 claim 1) for resetting said first display means and said second display means; and
- a switching means (lines 6-7 claim 1) for switching between a connected state and a disconnected state such that said second chronograph gear of said chronograph drive train is connected to said first gear of said first drive train when said switching means is in said connected state, said second display means being superimposed with said current measuring time hand when said second chronograph gear is connected to said first gear.

6. With respect to claim 15 US patent, 7232254, claims a chronograph watch movement, including a frame, the chronograph watch movement comprising:

- an energy source (energy is inherently required to perform time measurement);
- a time base (line 5 of claim 1) powered by the energy source;
- a current measuring time hand ("current time display means" line 3 claim 1);
- a first drive train ("current time display means" line 3 claim 1 and movement line 1) rotating in synchronization with said time base, said first drive train element including a first gear connected to said current measuring time hand;

a chronograph mechanism including:

- a measuring time hand and a second hand ("measured time display means" line 4 claim 1);
- a second chronograph drive train ("measured time display means" line 4 claim 1 and "movement" line 1) for driving in synchronism with said time base, said second chronograph drive train including a first chronograph gear connected to said second hand and a second chronograph gear connected to said measuring time hand, said first chronograph gear completing one revolution in sixty seconds, said second chronograph gear completing one revolution in sixty minutes, said first chronograph gear and said second chronograph gear being arranged coaxially with said first gear of said first drive train;
- a control means (lines 6-7 claim 1) for controlling said first chronograph gear and said second chronograph gear;
- a resetting means ("a reset device" lines 8-9 claim 1) for resetting said measuring time minute hand and said second hand;
- a switching means (lines 6-7 claim 1) for connecting said second chronograph gear of said chronograph drive train to said first gear of said first drive train, said measuring time hand being superimposed with said current measuring time hand and rotating therewith when said second chronograph gear is connected to said first gear.

7. Claims 2, 9, and 16 depend from claims 1, 8, and 15 respectively.

US patent, 7232254, teaches the limitations of the parent claims, but does not teach wherein said unit of current time and said unit of measured time is a minute.

Dubois teaches measuring time in units of a minute.

At the time of the invention it would have been obvious to one skilled in the art to measure time in units of a minute as taught by Dubois. The suggestion or motivation for doing so would be to indicate the measured time in well known units of time.

8. With respect to claims 5, 12, and 19 the US patent, 7232254, in view of Dubois discloses a movement according to claims 2, 9, and 16 respectively, wherein the chronograph mechanism further includes a locking device (lines 9-17 claim 1) arranged for locking the control device while the switching means are connecting the second wheel of the second train to said mobile.

9. With respect to claims 7, 14, and 20 the US patent, 7232254, in view of Dubois discloses a movement according to claims 5, 12, and 16 respectively.

The US patent, 7232254, does not claim wherein only the second wheel carries a minute hand, such that the latter displays the current time minutes while the locking device is locking the control device, and the measured time minutes in the opposite case.

Dubois teaches such a wheel carrying only a minute hand.



At the time of the invention it would have been obvious to one skilled in the art to provide a second wheel carrying only a minute hand, as taught by Dubois. The suggestion or motivation for doing so would be provide a separate wheel for indicating measured minutes as opposed to current time minutes thus allowing the current time to be operated when the measured time is not, as taught by Dubois.

***Allowable Subject Matter***

10. Claims 3, 4, 6, 10, 11, 13, 17, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 11/9/2007 have been fully considered.

The new title is not descriptive. The objection to the title has not been removed. A new title has been suggested above.

The amendments to claims 1 and 7 do remedy the indefiniteness issues previously involved therewith.

Applicant's arguments with regard to the rejection of claims 1-2 as being anticipated by Dubois et al. US 4389122, are found to be persuasive.

Applicant's arguments with regard to the rejection of claims 1-2 and 5-7 based on nonstatutory obvious-type double patenting are not persuasive. The attached terminal disclaimer is improper and is disapproved. The assignee in the current application is

VMF whereas the assignees in the '254 patent are VMF and Complitime (each having partial interest in the patent.)

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Kayes whose telephone number is (571) 272-8931. The examiner can normally be reached on 8:00-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Paula can be reached on (571) 272-2800 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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SK  
1/11/2008

  
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